

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/530,564  
for the mark YOUR INSTITUTIONAL PRIVATE INVESTOR  
Filed on July 17, 2003  
Published for Opposition in the Official Gazette  
of February 17, 2004 (TM 370)



08-16-2004

U.S. Patent & TMOfc/TM Mail Rcpt. Dt. #40

CHARLOTTE BEYER ASSOCIATES, INC. DBA  
INSTITUTE FOR PRIVATE INVESTORS,

Opposer,

V.

ALLIED MORTGAGE & FINANCIAL  
CORPORATION,

Applicant.

OPPOSITION NO.:

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

## NOTICE OF OPPOSITION

Opposer, Charlotte Beyer Associates, Inc. DBA Institute For Private Investors, believes that it will be damaged by registration of the mark YOUR INSTITUTIONAL PRIVATE INVESTOR in International Class 36 as shown in Application Serial No. 76/530,564, which was published for opposition in the Official Gazette of February 17, 2004 at Page TM 370, and hereby opposes the same.

Opposer was previously granted a ninety (90) day extension of time and a further sixty (60) day extension of time to file its Notice of Opposition, thereby extending Opposer's time to file its Notice of Opposition to August 15, 2004.

As grounds for the opposition, it is alleged as follows:

1. Opposer is a New York corporation having an address at 74 Trinity Place, New York, New York 10006. Opposer is now and for many years has been engaged in the business of providing financial information to investors and arranging and conducting business and educational conferences and seminars in the field of wealth management.

2. Since at least as early as 1993, and for several years prior to February 1998, the date of first use alleged by Applicant in its application for the mark YOUR INSTITUTIONAL PRIVATE INVESTOR, Opposer has been engaged in the business of providing financial information to investors and arranging and conducting business and educational conferences and seminars in the field of wealth management under or in connection with the name and mark INSTITUTE FOR PRIVATE INVESTORS. Opposer's use of the name and mark INSTITUTE FOR PRIVATE INVESTORS has been valid and continuous since its date of first use and has not been abandoned.

3. Opposer is the owner of United States Application Serial Nos. 76/456,011 in Classes 36, 35 and 41 and 76/976,080 in Class 38 for the mark INSTITUTE FOR PRIVATE INVESTORS. The filing date of Opposer's applications is October 7, 2002 and prior to the filing date of Applicant's application.

4. Because Opposer's use of its name and mark INSTITUTE FOR PRIVATE INVESTORS and the filing date of its applications to register the mark INSTITUTE FOR PRIVATE INVESTORS are prior to Applicant's alleged date of first use of YOUR INSTITUTIONAL PRIVATE INVESTOR and the filing date of Applicant's application for YOUR INSTITUTIONAL PRIVATE INVESTOR, there is no issue of priority.

5. For several years, and long prior to Applicant's alleged first use of YOUR INSTITUTIONAL PRIVATE INVESTOR, Opposer has made significant efforts and expended

significant sums of money to promote and advertise the name and mark INSTITUTE FOR PRIVATE INVESTORS.

6. As a result of its considerable advertising and promotion by Opposer, and Opposer's long use of the name and mark INSTITUTE FOR PRIVATE INVESTORS, the name and mark INSTITUTE FOR PRIVATE INVESTORS has acquired and currently possesses an extensive and favorable reputation reflected in a substantial amount of good will which is owned by Opposer.

7. Opposer's name and mark INSTITUTE FOR PRIVATE INVESTORS identifies and designates services emanating from Opposer and distinguishes Opposer's services from those of others and is famous and of great value to Opposer. Opposer's name and mark became famous and distinctive prior to Applicant's first use of Applicant's mark.

8. Upon information and belief, Applicant Allied Mortgage & Financial Corporation is a Florida corporation having an address at 4651 Sheridan Street, Suite 100, Hollywood, Florida 33021.

9. Applicant seeks to register YOUR INSTITUTIONAL PRIVATE INVESTOR for "mortgage lending and brokerage services" in Class 36. Applicant filed its application on July 17, 2003 based upon its alleged use of YOUR INSTITUTIONAL PRIVATE INVESTOR in commerce since February 1998.

10. Applicant's mark is virtually identical and confusingly similar to Opposer's name and mark.

11. The services for which Applicant seeks to register its mark are related and confusingly similar to the services in connection with which Opposer uses its name and mark.

12. In view of the confusing similarity of the marks and the relatedness of the services of the respective parties, Applicant's use and registration of YOUR INSTITUTIONAL PRIVATE INVESTOR is likely to cause in the minds of the relevant trade and public the erroneous and false impression and implication that Opposer is in some manner responsible for, or has sponsored, approved or endorsed Applicant's services or that Applicant is in some way associated or connected with Opposer.

13. Applicant's use and registration of YOUR INSTITUTIONAL PRIVATE INVESTOR is likely to cause confusion with Opposer's name and mark INSTITUTE FOR PRIVATE INVESTORS all to the damage of Opposer.

14. The use and registration by Applicant of its mark dilutes the distinctive quality of Opposer's famous mark.

15. The application should therefore be refused registration pursuant to Section 2 of the Trademark Act of 1946 as amended (15 U.S.C. § 1052) on the grounds that Applicant's mark YOUR INSTITUTIONAL PRIVATE INVESTOR so resembles Opposer's name and mark INSTITUTE FOR PRIVATE INVESTORS as to cause confusion, mistake and deception.

16. The application should therefore also be refused registration because registration of Applicant's mark will be a source of damage and injury to Opposer since Applicant's mark dilutes the distinctive quality of Opposer's famous name and mark.

17. The application should therefore also be refused registration because if a registration is issued to Applicant, such registration will constitute a prima facie exclusive right to Applicant's mark. Such a registration will be a source of damage and injury to Opposer since it will cause the trade and/or purchasing public to believe that Applicant has a right superior to

that of Opposer, to believe that Applicant's quality represents the quality of Opposer's services, and will place a cloud on Opposer's title to its name and mark.

WHEREFORE, Opposer prays that the Opposition be sustained and Applicant's application be refused registration.

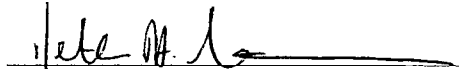
The Notice of Opposition is filed in duplicate as required by the Trademark Rules of Practice. Enclosed herewith is a check in the amount of \$300.00 as required by 37 C.F.R. Section 2.6(a)(17). Please charge any other fees which may be applicable to Deposit Account No. 502964 in the name of Seward & Kissel LLP.

All communications regarding this Opposition proceeding should be directed to Opposer's counsel, Seward & Kissel LLP, at the below-stated address.

Dated: August 16, 2004

Respectfully submitted,

SEWARD & KISSEL LLP

By:   
Beth H. Alter

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Attorneys for Opposer

CERTIFICATE OF MAILING

Notice of Opposition

In the matter of Trademark Application

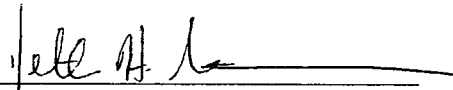
Serial No.: 76/530,564

Filed: July 17, 2003

Published: February 17, 2004

Date of Deposit: August 16, 2004

I hereby certify that the above-identified correspondence, which is attached, is being deposited with the United States Postal Service with sufficient postage as first class mail on the date indicated above and is addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

  
Beth H. Alter

Dated: August 16, 2004